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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/587,091

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Salvatore Carbone

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IP STRATEGIES
12 1/2 WALL STREET
SUITE E
ASHEVILLE, NC 28801

EXAMINER

LONG, ROBERT FRANKLIN

ART UNIT

PAPER NUMBER

3764

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/587,091	Applicant(s) CARBONE, SALVATORE	
	Examiner Robert F. Long	Art Unit 3764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 22 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrase "adapted to store in memory data representing arm positions and to lift and position the arms during a later exercise session according to the stored data" errs toward new matter not fully addressed in the specification. Although the specification states the switchboard is able to memorize the different positions it is does not mention *using the data representing arm positions to lift and position the arms during a later exercise session according to the stored data*. Further, the specification does not provide adequate enabling means to achieve a data storage processor, computer, and/or storage medium. Appropriate action is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. **Claims 15-21 and 23-30** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Rodriguez (US 5779602) in view of Rodriguez (US 6086520)**.

Regarding claim 15 -17 and 21, Rodriguez discloses a gym work-out equipment for the training of the chest, deltoids, trapeziums and triceps muscles, **10, (Abstract)** comprising: a bench, including a back-rest, that allows an athlete to do exercises with the back-rest in a horizontal position for stretching and pectoral crosses, **bench figure 1, (Abstract)** and an assist system, 10, including servomechanism arms **44/46** adapted to hold weights, a mechanical, hydraulic, electrical or pneumatic lift system adapted to lift the arms, and a command device that controls the assist system when activated through the use of rods, pedals, switches or push buttons; wherein the arms are adapted to lift the weights held by the arms under control of the command device, to assist the athlete without requiring the athlete to get up from or change the position of the bench, wherein the arms are adapted to position the weights with respect to the bench and the exercise to be performed by the athlete. Wherein the arms include a universal bracket system to position the weights and related equipment.

Assist arms for positing weight, **Upper Surface 44/U-shaped receiver 46. Such U-shaped receiver is for supporting the horizontal bar of free weights**, (column 5, lines 9-23, figures 1-2, Abstract, column 3, lines 1-67, column 4, lines 38-52).

foot pedal control/pneumatic servomechanism, **pedal 78 with pneumatic lines 80 coupled through an actuator 82**. The pedal is positionable in a plurality of orientations. It functions to receive the free end of the cable. In this manner, it may effect the withdrawal of the cable and pin from the recesses of the intermediate support plate. Such action is to allow for the **raising of the bracket in support of the depression of the pedal switch**, (column 5, lines 58-67),

commanding device via foot controller, **stepping on the footpad, laying the weights on the chest, or bending a knee more than 45 degrees. All of these actions will activate the controller**, (column 6, lines 28-38).

But fails to disclose a moveable bench 22, a slanted position for pectoral crosses and an up-right position for deltoids and stretching with dumb-bells for triceps

Rodriguez (US 6086520) discloses **a moveable bench 22**, a slanted position for pectoral crosses and an up-right position for deltoids and stretching with dumb-bells for triceps; *employed in conjunction with other exercises, such as the inclined bench presses, the butterfly press, and leg lifting exercise*, (column 2, lines 49-56). Rodriguez (US 6086520) also teaches an emergency pedal, 24, activation control button 54, (figure 3) and teaches using them to control/stop the servo arms, (column 3, lines 20-30, column 3, lines 44-50, Abstract, figures 1-3). Rodriguez also teaches adjusting the height of the arms via, *interconnection being achieved through an adjustment pin 44*.

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*This pin 44 enables the system to **accommodate the arm span of differing users.***

FIGS. 2 and 3 illustrate two possible adjustments between the support shaft 38 and rest 42, (column 2, lines 61-67, column 3, lines 1-5).

Thus, since Rodriguez teaches two styles of actuating arms with a bench and arms working in *conjunction with other exercises such as the inclined bench*, it would have been obvious for an exercise artisan to incorporate the commonly used adjustable/movable bench with the servo arms.

Also, where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, (*as shown here*), a prima facie case of either anticipation or obviousness has been established, *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). Moreover, it has been held to combine teachings is obvious, "It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... The idea of combining them flows logically from their having been individually taught in the prior art." *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

Regarding claims 18 and 20, Rodriguez in view of Rodriguez teaches the lift system is a mechanical system of levers and pulleys, and the command device includes pedals for activation of the lift system and control of the arms via an analogous rod, tension spring, and gear system that usually comprises pulleys, rods and levers, *Rodriguez (US 5779602) - **rod 86 is rotatable** about a horizontal axis to raise or lower*

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*the intermediate base 73 **through a gear assembly**. The intermediate base is raised and lowered, (column 5, lines 58-67 and column 6, lines 1-16).*

Thus, since gear systems usually comprise levers/rods and pulleys it would have been obvious for an exercise artisan to implement these commonly used parts to work in conjunction with the pneumatic lift system which also could be substitute with a hydraulic since either the hydraulic or pneumatic cylinders would serve the purpose of elevating or lowering the arms and are both commonly used interchangeably for the same lifting means. Also, since it has been held that broadly providing a mechanical or automatic means to replace a manual activity which has accomplished the same result involves only routine skill in the art., *In re Venner*, 120 USPQ 192. then a mere substitution of automatic means would thus be an obvious variant of the same.

Regarding claim 19, Rodriguez in view of Rodriguez discloses a lift sytem that is an electromechanical system, and the command device includes switches for activation of the lift system and control of the arms, ***pedal 24/activation control button 54/electric motor 48***, (Rodriguez (US 6086520), Abstract, column 3, lines 6-30).

Regarding claim 23, Rodriguez in view of Rodriguez discloses a foot rest, *trouble while lifting weights, he or she can activate this device by stepping on the footpad*, (Rodriguez (US 5779602) column 6, lines 16-37).

Regarding claims 24-25, Rodriguez in view of Rodriguez discloses a barrier around the operating parts for protection and safety for passers by who could come in contact with moving parts and/or to be used as support for advertising material, ***housing 12 with walls 14, 16 and roof 18, also has a base plate 24***. The base plate

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has an upper surface 26 and a lower surface 28. The upper surface is for receiving the lower edges of the wall. It has adjustable legs 30 extending from the two sides and front of the base plate 24 in a downward direction, (Rodriguez (US 5779602), column 4, lines 53-67, figures 1-3).

Regarding claims 26-30, These claims cover the same subject matter, despite a slight difference in wording, and are being substantially close enough to the prior claims (1-25) that the cited reference notes to those claims cover this subject matter as well.

6. **Claim 22** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Rodriguez (US 5779602) in view of Rodriguez (US 6086520) in view of Slattery (US 6632159).**

Regarding claim 22, Rodriguez in view of Rodriguez fails to disclose a memory data system.

Rodriguez (US 6086520) does teach adjusting the height of the arms with pins working in conjunction with an electrical motor, via, *interconnection being achieved through an adjustment pin 44. This pin 44 enables the system to **accommodate the arm span of differing users**. FIGS. 2 and 3 illustrate two possible adjustments between the support shaft 38 and rest 42, (column 2, lines 61-67, column 3, lines 1-5).*

Slattery uses a similar automatic supporting arms with memory used calculate revolutions for position determination, *stored in its memory to convert the line count into revolutions, (column lines 50-67).*

Here the prior arts teach lifting support arms and Slattery teaches a memory used to position the arms. *Thus*, where the claimed and prior art products are identical

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or substantially identical in structure or composition, or are produced by identical or substantially identical processes, (*as shown here*), a prima facie case of either anticipation or obviousness has been established, *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). Moreover, it has been held to combine teachings is obvious, "It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... The idea of combining them flows logically from their having been individually taught in the prior art." *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

Response to Arguments

7. Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection of newly cited art. Also, as previously stated the amended claims contain new subject matter, specifically claim 22, which is not enabling and/or new matter.

Conclusion

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. **Walker; Christopher W. et al. (US 5058888 A) and Mauriello; Anthony (US 5688216 A)** and Colbo Jr. (US 5281193) teaches a movable bench with adjusting arms, pneumatics -actuator 38 of the platform height adjusting mechanism 36 is a pneumatic actuating cylinder having telescoping parts 38A, 38B, (column 5, lines 45-50).

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert F. Long whose telephone number is (571)270-3864. The examiner can normally be reached on 5-4-9 (7:30-5).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, LoAn Thanh can be reached on (571) 272-4966. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert F Long/
Examiner, Art Unit 3764
Friday, December 19, 2008

/Fenn C Mathew/
Primary Examiner, Art Unit 3764